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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/537,651

10/31/2005

Charles Mark Lindall

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EXAMINER

MCDONOUGH, JAMES E

ART UNIT

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1793

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/537,651	Applicant(s) LINDALL ET AL.	
	Examiner JAMES E. MCDONOUGH	Art Unit 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 7-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-6 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ridland et al. (EP 0 812 818 A1).

Regarding claims 1 and 6

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Ridland teaches a catalyst comprising the reaction product an orthoester or condensed orthoester of metal such as titanium or zirconium, an alcohol containing at least two hydroxyl groups, a 2-hydroxy acid and a base (abstract).

Although, Ridland does not explicitly teach the use of 0.01-0.79:1 base to acid, Ridland teaches the preferred amount is 0.8-1.2:1, Ridland further teaches "Frequently the amount of base used is sufficient to fully neutralize the 2-hydroxy carboxylic acid but it is not essential that the acid be fully neutralized. Therefore, for monobasic 2-hydroxy acids such as lactic acid, the preferred amount of base is in the range 0.8 to 1.2 mole per mole of 2-hydroxy acid" (page 3, fourth full paragraph), and a reference is good for all that it teaches and is not limited to the preferred embodiments, and it is the opinion of the examiner that this reads on and anticipates amounts below 0.8, even if not preferred. On the other hand one of ordinary skill in the art at the time of invention would have determined the optimal ratio of base to acid through routine experimentation in the art, in an effort to optimize the catalyst performance.

Regarding claim 2

Ridland teaches diethylene glycol (page 3, first full paragraph).

Regarding claim 3

Ridland teaches the use of lactic acid (page 3, fourth full paragraph).

Regarding claim 4

Ridland teaches the use of 1 to 4 moles of acid per mole of metal (page 3, third full paragraph).

Regarding claim 5

Ridland teaches the use of sodium hydroxide (page 3, fourth full paragraph).

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ridland et al. (EP 0 812 818 A1), as applied to claim 1 above.

Although, Ridland does not teach that the ratio of base to 2-hydroxy acid is 0.01-0.6:1, Ridland does teach “Frequently the amount of base used is sufficient to fully neutralize the 2-hydroxy carboxylic acid but it is not essential that the acid be fully neutralized. Therefore, for monobasic 2-hydroxy acids such as lactic acid, the preferred amount of base is in the range 0.8 to 1.2 mole per mole of 2-hydroxy acid”, which shows using less than 1:1, further the reference teaches “In the case of citric acid (a tribasic acid), the preferred amount [of base] is in the range 1 to 3 moles base per mole hydroxyl acid” (page 3, fourth full paragraph), Which would suggest to the skilled artisan using 0.67-1:1 base per acid equivalent, however the amount of base used would have been determined through routine experimentation in the art, absent any evidence of unexpected result or criticality for the specifically claimed range.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.

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1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-6 and 16 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12 of copending Application No. 10/432,510. Although the conflicting claims are not identical, they are not patentably distinct from each other because the catalyst of the reference has additional components, however the comprising language of the instant invention does not disallow this.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

Applicants argue against the 102/103 rejection over the claims.

Applicants argue that Ridland does not expressly disclose that the ratio of base to acid is less than 0.8:1. While this may be true, it is not persuasive because the reference does suggest the use of less base and teaches that 0.8-1.2 is the preferred range, and one skilled in the art would appreciate that a reference is not limited to the

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preferred embodiments. Further the teaching of using 1-3 moles of base when using a tribasic acid, would suggest the use of 0.67-1 moles of base per equivalent of acid.

Applicants argue that the declaration submitted by Calum Harry McIntosh, shows unexpected results were found when lowering the amount of base. This is not persuasive and the declaration has been fully considered but is not persuasive because there is no comparison of the closest prior art, as the declaration only compares 0.67:1, 0.8:1 and 1.2:1, and argues that better results are achieved with 0.8:1 and 0.67:1 versus the 1.2:1, it is noted that the reference clearly discloses as the preferred embodiment 0.8:1, and would appear to suggest less, however applicants have not compared 0.8 to 0.79 or 0.8 to 0.67 and shown unexpected results or any criticality for the claimed range as compared to the closest prior art.

Applicants argue that they have discovered localized concentrations of sodium and titanium were the source of the breakage in the polyester fibers of Ridland. This is not persuasive because applicants used 1.2:1 base to acid and Ridland teaches using as low as 0.8:1 base to acid as the preferred embodiment, and appears to suggest the use of lower amounts, based on the reasoning given in the rejection above, while the instant invention claims the use of less than 0.79:1, however applicants have shown no criticality for this range versus 0.8:1, nor have any unexpected results been demonstrated.

Applicants remaining arguments against the prior art rejection have been fully considered, but are not persuasive for the same reasons given above.

Applicants have submitted an affidavit in an attempt to show unexpected results. This declaration has been fully considered but is not persuasive for the same reasons given above (i.e. does not compare the closest prior art ratio of base to acid).

Applicants argue against the double patenting rejections.

First it is noted that since copending application serial number 10/574,976 has been abandoned the double patenting rejection over this reference has been withdrawn.

Applicants argue that the double patenting rejection is not proper and should be withdrawn at least because "Claim 1 recites a finite range of molar ratio of base to 2-hydroxycarboxylic acid, which is not claimed in either of the co-pending applications". This is not persuasive because the remaining double patenting rejection over copending application serial number 10/432,510, clearly teaches in claim 8 a ratio of acid to base that while not being identical to the instant application does overlap that of the instant invention, thereby making the recited range obvious.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES E. MCDONOUGH whose telephone number is (571)272-6398. The examiner can normally be reached on 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571)272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/J.A. LORENZO/

Supervisory Patent Examiner, Art Unit 1793

JEM 7/27/2009